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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/833,345

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Rabindranath Dutta

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09/07/2006

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EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/833,345

Applicant(s)

DUTTA ET AL.

Examiner

Dan Kesack

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 11, 18-20 and 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10, 12-17 and 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/20/01; 7/25/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: PTO-1449 Date 8/8/05; 10/24/05; 12/16/05; 1/30/06; 3/21/06; 7/17/06; 8/15/06.

### DETAILED ACTION

1. This application has been reviewed. Original claims 1-29 are currently pending.  
The rejections are as stated below.

#### *Election/Restrictions*

2. Claims 7-9, 11, 18-20, 27-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 19, 2006.

#### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 10, 12, and 21 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. 35 U.S.C. 101 requires that in order to be patentable the invention must be a "new and useful process,

machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added).

Claims 1, 10, 12, and 21 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to a non-statutory subject matter. Specifically the claimed invention as a whole does not accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." See *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention. The mere fact that the claims recite processing the bill does not satisfy the requirement of 35 U.S.C. 101. Without any kind of useful output from the processing, the claimed method has no practical application or utility. The claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore is non-statutory under 35 U.S.C. § 101. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

In the interest of compact prosecution, and for application of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3624

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3, 5, 6, 10, 12, 14, 16, 17, 21, 23, 25, and 26 are rejected under 35

U.S.C. 102(e) as being clearly anticipated by Powar, U.S. Patent No 6,438,527.

Claims 1, 3, 10, 12, 14, 21, 23, Powar discloses a method and apparatus for paying bills electronically using machine readable information from an invoice, for use at an ATM, comprising scanning a bill to form a bill image, wherein the bill image includes a barcode providing payment information, performing optical character recognition on the bill image to identify the payment information and processing the bill using the payment information (column 2 line 65 – column 3 line 5 and column 5 line 63 – column 6 line 35).

Claims 5, 16, 25, Powar teaches presenting payment options to the user and initiating a transfer of funds to pay the bill in response to a selected user input using a payment option selected by the user (column 5 lines 32-45).

Claims 6, 17, 26, Powar teaches displaying an amount of the bill to a user (column 6 lines 18-25).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 4, 15, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powar, as applied above, and further in view of Hidaka et al., U.S. Patent No 6,782,402.

Powar fails to teach adding a time stamp to the bill image.

Hidaka teaches a system and method for gathering image data by a scanner and storing said data in an image file, along with a timestamp (column 48 line 60 – column 49 line 10). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Powar to include a time stamping the image data for record keeping purposes as a record of when the bill was processed

Art Unit: 3624

because such a record is vital and necessary for keeping records of invoices issued and bills paid.

9. Claims 2, 13, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powar, as applied above, and further in view of Nishijima et al., U.S. Patent No. 7,088,907.

Powar fails to teach generating a video recording of the user during processing of the bill.

Nishijima teaches a video camera that is disposed near an automatic teller machine for capturing video of a user at the ATM, and attaching user information to the image capture. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Powar to include the video camera capturing device of Nishijima because the camera provides security, and security is very much desired at automatic teller machines.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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